

Attorney Ref. No. 26992.000

Serial No. 75/334,378

Mark: OMEGA METER & Design

**IN THE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD**

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In re Application of :  
Specialty Coating Systems, Inc. (by :  
assignment from Fry's Metals, Inc. d/b/a :  
Alpha Metals, Inc.) :

Serial No. 75/334,378 :

Filed August 1, 1997 :

For Mark OMEGA METER & Design  
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**TTAB**

Commissioner for Trademarks  
ATTN: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**APPEAL BRIEF OF APPLICANT**

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## STATEMENT OF FACTS

On August 1, 1997, Applicant Alpha Metals, Inc. filed the present use-based application to register the mark OMEGA METER & Design for an "apparatus for measuring the residual ionic contamination of electronic parts, components and printed wiring assemblies" in International Class 9 claiming a first use date of September 23, 1975 (the "Application").

On May 4, 1998, the Examining Attorney, John Tingley, Esq., issued an Office Action refusing registration to applicant, inter alia, under Trademark Act Section 2(d) because he found the mark shown in the Application to be confusingly similar with the marks shown in Registration Nos. 1,045,835, 2,022,762 and 2,034,705.

Applicant responded to the Office Action by arguing that it owned Registration No. 1,045,835 of the identical mark and for the identical goods (the "OMEGA METER & Design Registration"). Applicant purchased all the assets of Kenco Alloy & Chemical Co., Inc., the record owner of the OMEGA METER & Design Registration. However, due to an oversight in the purchase documents, the OMEGA METER & Design Registration was not formally assigned to applicant, and consequently Applicant was unable to renew the OMEGA METER & Design Registration. Applicant subsequently filed the Application for the same mark and covering the same goods as appeared in the OMEGA METER & Design Registration. In response to the Examining Attorney's refusal, Applicant argued that the Application should be accepted because the OMEGA METER & Design Registration coexisted on the register with the other registrations cited by the Examining Attorney, namely Registration Nos. 2,022,762 and 2,034,705.

In an Office Action dated November 20, 1998, the Examining Attorney withdrew the citation of the OMEGA METER & Design Registration and of Registration No. 2,034,705, but

continued and made final the refusal of the Application under Section 2(d) due to Registration No. 2,022,762. On May 20, 2006, applicant filed a Notice of Appeal and Request for Reconsideration. By notice dated September 29, 1999, the Trademark Trial and Appeal Board (the "TTAB") suspended the appeal pending a final determination in Cancellation No. 92,027,575 against Registration No. 2,022,762.

On April 10, 2006, the Examining Attorney denied applicant's Request for Reconsideration. The TTAB resumed the appeal by notice dated April 13, 2006, which gave Applicant sixty days in which to file its appeal brief.

### **ISSUE**

Whether the mark OMEGA shown in Registration No. 2,022,762 is confusingly similar to Applicant's mark OMEGA METER & Design shown in the Application under Trademark Act Section 2(d).

### **ARGUMENT**

Applicant believes that the Examining Attorney did not properly consider the fact that the Trademark Office granted registration to OMEGA while the OMEGA METER & Design Registration was valid, concluding that that there is no likelihood of confusion presented by the parties' marks, which may coexist on the Principal Register. In fact, the same Examining Attorney who denied registration of the Application, John Tingley, Esq., granted registration to the mark OMEGA while the OMEGA METER & Design Registration existed on the register. In his refusal of the Application, the Examining Attorney cited no evidence of any changes in the relevant marketplace that would support his inconsistent position.

In the alternative, Applicant respectfully submits that there is no likelihood of confusion between applicant's mark OMEGA METER & Design and the mark shown in the cited

registration, OMEGA given the nature and cost of the parties' goods and the sophistication of the purchasers, who are making carefully researched deliberative purchasing decisions. In fact, the parties have coexisted for over thirty years with no instances of actual confusion, which is probative evidence that no likelihood of confusion exists.

1. The Examining Attorney, John Tingley, Esq., Previously Concluded that the Parties' Marks May Coexist on the Principal Register

The Application was refused by Examining Attorney John Tingley, Esq. This same Examining Attorney granted registration to Omega Engineering, Inc. for its mark OMEGA on December 17, 1996, allowing it to overcome a Section 2(d) citation of the OMEGA METER & Design Registration, which covered the identical mark and the identical goods in the Application and which was owned by applicant's predecessor in interest. It is inconsistent for the same Examining Attorney to conclude in 1994 that applicant's OMEGA METER & Design mark and the OMEGA mark give rise to no likelihood of confusion, and then to conclude in 1998 that confusion is likely. The Examining Attorney introduced no evidence of any change in the relevant marketplace between 1994 and 1998 that would support this inconsistent result.

Applicant respectfully submits that the Examining Attorney's 1998 refusal be reversed, and that the refusal under Section 2(d) of the Lanham Act be removed on these grounds alone.

2. The Marks Designate Different Goods and Target Different Groups of Sophisticated Purchasers

In the alternative, Applicant respectfully requests that the Section 2(d) refusal be removed because there is no likelihood of confusion between the parties' marks.

Even when marks are identical, no likelihood of confusion exists where the respective goods and services are sufficiently unrelated and are directed to different potential customers. See, e.g., Saks & Co., 12 U.S.P.Q.2d 1833 (T.T.A.B. 1989) (services in the nature of promoting

the interests of the snack food industry not sufficiently related to retail food store and department store services and various snack foods sold therein); In re Shipp, 4 U.S.P.Q.2d 1174 (T.T.A.B. 1987) (PURITAN and Design for laundry and dry cleaning services not confusingly similar to PURITAN for dry cleaning machine parts or to PURITAN for dry cleaning preparations); Triumph Mach. Co. v. Kentmaster Mfg., Co., 1 U.S.P.Q.2d 1826 (HYDRO-CLIPPER for power operated cattle de-horning shears not confusingly similar to HYDRO-CLIPPER and HYDRO-CLIPPER & Design for power mower attachment for controlling vegetation).

Moreover, confusion is unlikely where, as here, the potential purchasers of the goods and services are highly sophisticated professional purchasers making careful, deliberative decisions to purchase expensive goods. See Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp., 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992) (emphasizing that purchasers' "sophistication is important and often dispositive" because they are expected to use greater care); 3 J. Thomas McCarthy on Trademarks and Unfair Competition § 23:101 (4<sup>th</sup> Ed. 2005); TMEP § 1207.01. Consumers such as Applicant's customers, i.e., quality and process engineers of electronics manufacturers, are making expensive, well-researched and deliberative purchases. This type of consumer exercises a greater level of care, thus minimizing a likelihood of confusion as to source. See, e.g., Magnaflux Corp. v. Sonoflux Corp., 231 F.2d 669 (C.C.P.A. 1956) (no likelihood of confusion between SONOFLUX for vibromagnetic inspection instrument to detect flaws in ferromagnetic materials and MAGNAFLUX for electrical apparatus for magnetic testing of metal articles because purchasers are sophisticated); 3 J. Thomas McCarthy § 23:97.

Applicant's mark OMEGA METER & Design designates an "apparatus for measuring the residual ionic contamination of electronic parts, components and printed wiring assemblies." The OMEGA METER & Design apparatus is a highly specialized apparatus that costs

approximately \$20,000 and is used by quality and process engineers of electronics manufacturers to measure the ionic contamination of electronic hardware and components caused by processing steps such as wave soldering, hot air leveling, plating, etching and chemical cleaning. The engineers making the decision to purchase Applicant's OMEGA METER & Design apparatus are extremely sophisticated, highly-trained and educated professionals who know that they are dealing with Applicant when they consider the purchase of Applicant's apparatus. These professionals exercise extreme care in making the decision to purchase an OMEGA METER & Design apparatus, and purchase the apparatus only after carefully researching Applicant and its products and reputation. In this market, the identity and reputation of the manufacturer is of critical importance.

Due to the nature and cost of Applicant's apparatus and the extreme care and deliberation exercised by the purchasers of Applicant's apparatus, no confusion is likely here.

3. The Parties' Long Coexistence Without Evidence of Confusion  
Demonstrates That There Would be No Likelihood of Confusion

Applicant has used its mark OMEGA METER & Design since September 23, 1975, and Omega Engineering, Inc. claims that it has used its mark OMEGA since September, 1962. Thus, the parties' marks have coexisted for over thirty years. Where, as here, the parties' marks have co-existed for such a long period, consumers are not likely to be confused as to the affiliation or sponsorship of the respective marks. See In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973) (length of time during which there has been concurrent use is factor in finding no likelihood of confusion).

Notably, Applicant is not aware of any instances of confusion between the parties' marks. Omega Engineering, Inc., in response to an Office Action in which the Examining Attorney cited the OMEGA METER & Design Registration against its application for the mark OMEGA, also



argued that there is no likelihood of confusion between the parties' marks. (A copy of Omega Engineering, Inc.'s response is attached as Exhibit A hereto.)

Thus, the parties believe that there is no likelihood of confusion between their respective marks which have coexisted for over thirty years without any actual confusion. Absence of actual confusion is recognized as proof that no likelihood of confusion exists between the marks. Barre-National, Inc. v. Barr Laboratories, Inc., 773 F. Supp. 735, 21 U.S.P.Q.2d 1755, 1762 (D.N.J. 1991) (absence of actual confusion for seventeen years between BARR and BARRE "weighs heavily against a finding of likelihood of confusion"); Aktiebolaget Electrolux v. Armatron Int'l, Inc., 999 F.2d 1, 27 U.S.P.Q.2d 1460 (1st Cir. 1993) (absence of actual confusion after long period of coexistence is highly probative in showing that no likelihood of confusion exists).

Thus, the Examining Attorney failed to consider the parties' long coexistence with no evidence of actual confusion, and the parties' belief that their respective marks are not confusingly similar.

### CONCLUSION

Applicant believes that it is entitled to registration of its OMEGA METER & Design mark because the Examining Attorney provided no evidence of any change in the relevant marketplace to justify the inconsistency in his position regarding a likelihood of confusion between the parties' marks. Moreover, the Examining Attorney failed to fully consider the history of this matter and, in particular, that the parties have coexisted for over thirty years with no evidence of actual confusion, and that the parties both believe that there is no likelihood of confusion between their marks. For the foregoing reasons, the Examining Attorney's final refusal to register should be reversed and the application should be passed to publication. To the

extent there is any doubt that the marks are confusingly similar, such doubt should be resolved in favor of Applicant by publishing Applicant's mark and allowing Omega Engineering, Inc. or any other person who believes that he or she would be damaged by the registration to file an opposition.

Dated: New York, New York  
June 12, 2006

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